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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/871,227 | 05/31/2001 | Hector F. DeLuca | 1256-00765 | 1698 |

7590 10/29/2003

Thomas M. Wozny
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Milwaukee, WI 53202

EXAMINER

BADIO, BARBARA P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1616

DATE MAILED: 10/29/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,227

Applicant(s)

DELUCA ET AL.

Examiner

Barbara P. Badio, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: |

First Office Action on the Merits

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 25, 2003 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Double Patenting

3. **The rejection of claims 1-4 and 9-32 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of US Patent No. 5,945,410 is maintained.**

Applicant argues that the claimed compounds have properties that are unexpected when compared to the closest exemplified prior art compound. Applicant's argument was considered but not persuasive for the following reason.

Applicant's showing and argument of unexpected properties is noted. However, the issue under the doctrine of obviousness-type double patenting is whether the

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claimed invention is made obvious in view of the cited reference. The examiner maintains that the claimed genus of compounds of the reference encompasses the presently claimed compounds. The reference also makes obvious the presently claimed compounds by its specific teachings of (a) 2-alkyl derivatives wherein alkyl denotes a radical of 1 to 10 carbons and (b) "ethyl" as an alkyl substituent in the 2-position of exemplified compounds (see col. 5, lines 11-14 and 44-49).

For this reason and those given in previous Office Actions, the rejection of claims 1-4 and 9-32 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of US Patent No. 5,945,410 is maintained.

4. The rejection of claims 5-8 and 33-56 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of US Patent No. 5,843,928 is maintained.

Applicant's argument and the examiner's response are similar to those discussed above in #3. Specifically, the cited reference teaches "ethylene" as an alkylidene substituent in the 2-position of exemplified compounds (see col. 6, lines 41-51).

For this reason and those given in previous Office Actions, the rejection of claims 5-8 and 33-56 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of US Patent No. 5,843,928 is maintained.

Claim Rejections - 35 USC § 103

5. The rejection of claims 1-4 and 9-32 under 35 USC 103(a) over DeLuca et al. ('410) is withdrawn.

6. The rejection of claims 5-8 and 33-56 under 35 USC 103(a) over DeLuca et al. ('928) is withdrawn.

Other Matters

7. It is noted that the filing of terminal disclaimers would overcome the obviousness-type double patenting rejections stated above in #s 3 and 4.

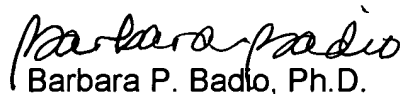
Telephone Inquiry

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 703-308-4595. The examiner can normally be reached on M-F from 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308- 2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

A handwritten signature in black ink, appearing to read "Barbara P. Badio".

Barbara P. Badio, Ph.D.

Primary Examiner

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BB

October 29, 2003